

REMARKS/ARGUMENTS

Claims 1, 3, 5, 7-10, 12-17, 19, 21, 23-26, and 28-32 are currently pending. Claims 2, 4, 6, 11, 18, 20, 22, and 27 are canceled herein. Claims 1, 5, 7, 12, 17, 21, 23, and 28 are amended herein. Applicant acknowledges receipt of the above-identified Office Action, and respectfully traverses the Office Action in its entirety.

REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0172010 to Butani et al (“Butani”) in view of Microsoft Computer Dictionary (“MCD”). Applicant respectfully traverses. However, in an effort to expedite examination of the instant application, Applicant has amended the claims to more clearly describe the claimed invention. More specifically, the claims have been amended to clarify and reinforce the concept previously set forth in the preamble of independent claims 1 and 17 that the current claims are directed to a system and method for consolidation of computing resources.

As described in the specification and recited in the claims, the instant claims are directed to a method and system for consolidating at least two computing devices, wherein information indicative of the characteristics of the computing devices (or a subset of the computing devices) is stored in at least two data sets. The characteristics stored in the at least two datasets comprises at least one of: system parameters, executable process parameters, and computing device database definition parameters. The characteristics of the at least two computing devices are loaded into a relational database for comparison to each other, thereby facilitating consolidation of the services performed on at least one of the computing devices.

By contrast, Butani is directed to systems and methods which “analyze and compare data, such as data contained in a bill of materials” (paragraph [0002]). More specifically, Butani discloses “determining the impact of one or more changes on a set of [bill of materials] data”, the results of which are “displayed in a manner that allows a user to compare the results of different analysis procedures and identify differences in those results” (paragraph [0014], emphasis added).

It is respectfully submitted that Butani is therefore so far outside the field of Applicant’s invention as to be irrelevant to the claimed invention. Put another way, one properly skilled in the art would not be motivated to look to Butani in attempting to consolidate computing systems,

in part because Butani does not teach or suggest consolidation of computing resources, storing computing device characteristics (i.e., information describing the computing device) in data files, loading computing device characteristics into a relational database, or evaluating computing device characteristics in a relational database for consolidation purposes. The Examiner has not provided any rationale as to why one skilled in the art would look to Butani, either alone or in combination with MCD, thus, it is respectfully requested that the Examiner withdraw the rejection.

Similarly, it is respectfully submitted that neither Butani nor MCD, either alone or in combination, teaches or suggests all elements of Applicant's claims. It is well settled that, for references to render obvious a claimed invention, all elements of the claimed invention must be present in the references. As described above, Applicant's claimed invention is directed to consolidation of computing devices, and, at the very least, Butani does not expressly or impliedly disclose such consolidation, and MCD fails to correct these deficiencies. Applicant therefore respectfully asserts that a *prima facie* case for obviousness has not been made, and respectfully requests that the Examiner withdraw the rejection.

Even if, without admission, Butani and MCD are seen as disclosing all elements of Applicant's claimed invention, Applicant respectfully asserts that the combination thereof would not have been obvious absent the hindsight provided by Applicant's invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. KSR Int'l Co. v. Teleflex, 127 S.Ct 1727, 1741 (2007). As former Chief Judge Markey of the Federal Circuit has stated, “virtually all inventions are ‘combinations’, and ... every invention is formed of ‘old elements’ Only God works from nothing. Man must work with old elements.” H.T. Markey, *Why Not the Statute?* 65 J. Pat. Off. Soc'y 331, 333-334 (1983). The factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. KSR Int'l Co. v. Teleflex, 127 S.Ct at 1742. In determining whether a claimed invention is an obvious combination of prior art references, it must be shown there is an apparent reason to combine the known elements in the fashion claimed. Id. at 1741. To facilitate review, this analysis should be made explicit. Id. The Examiner has not advanced a sufficient rationale as to why a person skilled in the art would have been motivated to combine Butani and MCD without the benefit of hindsight. Applicant therefore respectfully requests that the Examiner withdraw the rejection.

CONCLUSION

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that the currently pending claims are in condition for allowance and Notice to that effect is respectfully solicited. Additional characteristics or arguments may exist that distinguish the claims over the prior art, and Applicant respectfully reserves the right to present these arguments in the future, should they be necessary. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

AUTHORIZATION

The Commissioner is authorized to charge any additional fees associated with this filing, and credit any overpayment, to Deposit Account No. 19-3790. If an extension of time is required, this should be considered a petition therefor. If the fees associated with a Request for Continued Examination are filed herewith, this should be considered a petition therefor.

Respectfully submitted,

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